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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: 511 TRACK LIGHTING SYSTEM FOR 277 VOLT POWER LINE

Inventor: OLE K. NILSEN

Serial No: 06/889,746

Filed: 07/28/86

Group Art Unit: 266

Examiner: DAVID K. MOORE

I, OLE K. NILSEN, HEREWITH  
CERTIFY THAT THE DATE OF  
DEPOSIT WITH THE U.S. POSTAL  
SERVICE OF THIS PAPER OR FEE  
IS: 8-17-90

FILE WRAPPER CONTINUATION

Commissioner of Patents and Trademarks

Washington, D.C. 20231

~~File Wrapper Continuation Application is herewith filed  
under paragraph 1.62 of Rules of Practice in Patent Cases.~~

Original claims 1-19 are continued unamended, except for the correction of a typographical error in claim 16. All the pending claims are presented in a document attached hereto and entitled CLAIMS in FWC of Serial No. 06/889,746.

A check for \$221.00 (Check #3391) to cover the application fee is attached hereto, as is also a Statement re Small Entity Status.

REMARKS

The Board commented with respect to the possibility that the claims of instant application might overlap the claims in co-pending application Serial No. 08/889,171.

To obviate any possible issue related to so-called obviousness-type double patenting, Applicant submits herewith a Terminal Disclaimer.

The Board affirmed Examiner's original rejection of claims 1-19 under 35 USC 103 as being unpatentable over Spira in view of Kivari and Neumann.

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The Board also affirmed Examiner's original rejection of claims 1-19 under 35 USC 103 as being unpatentable over Nilssen in view of Kivari and Neumann.

So far in the prosecution of instant application, Applicant has focused on what he believes to be an unacceptable flaw in the procedure used by the Examiner (as well as by the Board and the Courts) in evaluating claims for patentability under 35 USC 103. This flaw relates to Examiner's position to the effect that -- irrespective of his own level of skill in the particular art pertinent to the case at hand -- he is in a position to render meaningful (i.e., informed) opinions with respect to what would (note: not what could) have been obvious to a person having ordinary skill in the pertinent art. The arguments used by the Board and the Courts in justifying this position are based on the "hypothetical person" concept; which concept -- except perhaps to persons not possessing much skill in the art in question -- is fatally flawed for the simple reason that this "hypothetical person" is, through the very manner in which he is defined, utterly extraordinary. To Applicant -- as well as to many highly experienced professional-level engineers and inventors personally known to him -- the "hypothetical person" concept constitutes a tragic joke with respect to representing a basis on which to identify what would have been obvious to a person having ordinary skill in the pertinent art.

[On the other hand, the "hypothetical person" concept would be meaningful as a basis for determining what could have been obvious to a person of ordinary skill; except, of course, the issue of significance pertains to what would have been obvious, not what could have been obvious.]

An opinion of any sort is clearly a subjective proposition: it is a judgment made by a person (i.e., by a subject) and it must, by absolute necessity, reflect the nature and state of that person at the time he rendered the judgment; that is, it reflects his skill, his prejudices, his intelligence, his educational level, his character, his state of alertness, etc.

Clearly, with respect to a given subject matter, the quality of an opinion rendered by a given person depends entirely upon that person's level of skill with respect to that particular subject matter. That is, the quality of an opinion rendered with respect to a particular subject matter must be presumed to be higher in a situation where the opinion is rendered by an expert in that particular subject matter as compared with a situation where the opinion is rendered by a person who is not an expert in that particular subject matter.

Based on his own particular type and degree of skill, which is testified-to in previously submitted Affidavit marked Exhibit A, Applicant has concluded that neither Examiner nor the Board has sufficient expertise with respect to the particular subject matter underlying the claimed invention to render meaningful interpretations and/or opinions with respect to facts associated with the various applied references, much less with respect to what may or may not constitute obvious modifications thereof.

Thus, as seen from Applicant's perspective, it is meaningless to argue/analyze facts with respect to the applied references for the reason that neither Examiner nor the Board is in the position to properly understand/appreciate all the relevant facts associated with the applied references -- even after having been prompted by Applicant.

So, instead of analyzing and arguing facts, Applicant herewith submits an Affidavit by a Mr. Dale Fiene, which Affidavit is marked Exhibit D.

Applicant believes that Examiner will agree that Mr. Fiene qualifies as an expert with respect to the subject matter at hand.

According to Mr. Fiene:

(1) It would be highly unusual, even inappropriate, to distribute the high-frequency voltage of Spira's lighting system by way of power tracks, such as used in track lighting systems of the type described by Neumann. Thus, it could hardly be considered obvious for a person having ordinary skill in the pertinent art to modify Spira's lighting system by using such power tracks for power distribution.

(2) The lamp described by Kivari does not represent a workable incandescent lamp. Clearly, Kivari did not understand the issues and consequences associated with the proposition of placing a 60 Hz transformer within the envelope of an otherwise ordinary incandescent lamps. Had the examiner prosecuting the application underlying Kivari's patent possessed at least ordinary skill in the pertinent art, he would not have allowed that patent for the reason that the invention claimed by Kivari lacks utility.

In particular, Kivaris' lamp would not be applicable for use in a track lighting system.

(3) On the basis of what is taught by the applied references, there would be no discernable benefit associated with using Spira's or Nilssen's frequency-converting power supply for powering the tracks in Neumann's track lighting system. On the contrary: doing so would only result in undesirable effects, such as: higher cost; lower efficiency; increased complexity; decreased reliability; electro-magnetic interference; more difficult installation; etc.

Thus, based on an expert's analysis and evaluation of facts and circumstances, there exists no factual basis for rejecting the claimed invention over the teachings of Spira, Nilssen, Neumann and Kivari.

As further evidence with respect to the unobviousness of the claimed invention, Applicant submits additional Affidavits marked Exhibits E through H.

According to Exhibits E and F, twice over, a person having at least ordinary skill in the art pertinent hereto swears to the effect that he does not find the claimed invention to constitute a desirable obvious modification and/or application of the teachings of Spira et al. in view of the teachings of Neumann and Kivari.

According to Exhibits G and H, twice over, a person having at least ordinary skill in the art pertinent hereto swears to the effect that he does not find the claimed invention to constitute a desirable obvious modification and/or application of the teachings of Kivari in view of the teachings of Spira and Neumann.

Clearly, Applicant has now provided ample evidence to the effect that the claimed invention represents unobvious subject matter over the applied references.

Yet, if -- contrary to Applicant's expectations -- Examiner were to require still more and/or different evidence, Applicant will have to comply. However, providing such evidence is a very costly proposition, especially if it is not entirely clear exactly what evidence is required and/or exactly what Examiner's position is.

So, to permit him to provide any additionally required evidence in a reasonably cost-effective manner, Applicant requests of Examiner -- in the event he were to reject any of the claims on the basis of 35 USC 103 -- to comply fully and literally with the express provisions of MPEP 706.02.

That is, for each and every claim rejected under 35 USC 103, Applicant request of Examiner to expressly set forth:

(1) the difference or differences in the claim over the applied reference(s);


(2) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter; and

(3) an explanation why such proposed modification would be obvious.

It be imperative for Examiner to present his position in such manner as to be readily understandable by a person having ordinary skill in the particular art pertinent hereto; otherwise, Applicant will be materially hindered in presenting Examiner's position to independent experts for their evaluation; which is to say: Applicant would be deprived of due process.

Clearly, one of the most crucial aspects of a "103" rejection relates to motivation operative to attain a given end result is that of obvious utility. Thus, in one way or another, Examiner must provide answers to the following questions:

- \* Does the alleged obvious end result indeed have utility?
- \* If so, what exactly is this utility?
- \* Is this utility suggested by the applied references?
- \* If so, where/how is it indeed suggested by/in the applied references?



Ole K. Nilssen, Pro Se Applicant